

REMARKS

Claim Numbering

The Applicant acknowledges with appreciation that misnumbered original claims 11-21 have been renumbered by the Examiner as claims 12-22. These renumbered claims have been listed on the preceding pages with the status identifier “previously presented,” except where the renumbered claims are currently amended

Section 112 Rejection

Claim 12 has been rejected as “failing to set forth the subject matter which applicant(s) regard as their invention.” The Examiner further states that “it is unclear as to the orientation of the plurality of arms.”

The Applicant has amended claim 12 so as to recite “a plurality of arms that incline outwardly from opposing sides of the column for elevated support of dumbbell bars at horizontally-displaced locations from respective connection points between the arms and the column.” FIGS. 1-2 illustrate, by example, one embodiment of this claimed invention. Thus, arms (20) incline outwardly from opposing sides of an upright column (26) so as to support dumbbell bars (22) at horizontally-displaced locations (see cradles (38a, 38b)) from the respective connection points (23) between the arms (20) and the column (26). Withdrawal of this rejection and reconsideration of claim 12 are respectfully requested.

Other Claim Amendments

Claims 13, 14, 20, and 22 have been amended so as to be consistent with amended claim 12.

Claim 1 has also been amended to clarify the invention, now reciting “at least two opposing arms.”

Anticipation Rejections

Claims 1, 9, 11, 12, and 18 stand rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent No. 6,709,370 (“Evans”).

Claims 12, 13, 17, and 20-22 stand rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent No. 4,729,561 (“Desjardins”).

These anticipation rejections are respectfully traversed because the cited references fail to

describe “each and every element as set forth in the claim,” as is required for a proper anticipation rejection. *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987).

Claim 1 and the rejected claims that depend therefrom (i.e., claims 9 and 11) all include the element of “a lower section having a plurality of bars affixed thereto and upon which weight-training plates having bores therethrough may be stored.” Applicant cannot understand how the Examiner could read Evans on this limitation of claim 1, as Evans fails to show any weight plates whatsoever in any of its drawings. An example of a weight plate is shown in broken lines and numbered as 16 in Applicant’s FIG. 1. The disclosure of Evans is limited to the support of dumbbells only. Reconsideration and withdrawal of these anticipation rejections are therefore respectfully requested.

Claim 12 (as amended) and the rejected claim that depends therefrom (i.e., claims 13, 17, 18, and 20-22) all include the element of “an upright, load-bearing column; and a plurality of arms that incline outwardly from opposing sides of the column for elevated support of dumbbell bars at horizontally-displaced locations from respective connection points between the arms and the column.” Neither Evans nor Desjardins discloses such inclined arms. In Evans, the dumbbell bars (106) are not supported at all by the cross arms (144, 146). Instead, the dumbbell weights (102, 104) are supported by the cross arms (144, 146), but in such a way as to position the dumbbell arms directly above the tubes 120, 122. Desjardins fails to disclose the support of dumbbells in any manner whatsoever, much less according to the claimed limitations. The disclosed bar supports (e.g., bar cradles (70)) are simply too narrow to support dumbbells. Reconsideration and withdrawal of these anticipation rejections are therefore also respectfully requested.

Obviousness Rejections

Claims 1, 2, and 4-8 stand rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 5,954,619 (“Petrone”) in view of U.S. Patent No. 5,891,004 (“Berry”).

Claims 1-3, 12, and 20 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Petrone in view of Desjardins.

Claims 10, 19, and 22 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Petrone in view of Desjardins, and further in view of Ho (patent number not identified by Examiner).

Claims 1 and 9 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Evans in

view of Berry.

These rejections are respectfully traversed because the Examiner has failed to present a *prima facie* case of obviousness. To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. *MPEP* § 2143. At least one of these criteria – and probably all three – is lacking, as explained below.

Section 103(a) of the patent statute (35 U.S.C.) states that “[a] patent may not be obtained . . . if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains.” In making the assessment of the “differences,” Section 103(a) specifically requires consideration of the claimed invention “as a whole.” Inventions typically are new combinations of existing principles or features. Env'tl. Designs, Ltd. v. Union Oil Co., 713 F.2d 693, 698 (Fed. Cir. 1983) (noting that “virtually all [inventions] are combinations of old elements.”). The “as a whole” instruction prevents evaluation of the invention on a piecemeal basis. Without this important requirement, an obviousness assessment might break an invention into its component parts (A + B + C), then find a prior art reference containing A, another containing B, and another containing C, and on that basis alone declare the invention obvious. This form of hindsight reasoning, using the invention as a roadmap to find its prior art components, would discount the value of combining various existing features or principles in a new way to achieve a new result – often the very definition of invention.

Section 103(a) precludes this hindsight-based discounting of the value of new combinations by requiring assessment of the invention as a whole. The Federal Circuit has provided further assurance of the “as a whole” assessment of the invention under Section 103 by requiring a showing that a person of ordinary skill in the art at the time of invention, confronted by the same problems as the inventor and with no knowledge of the claimed invention, would select the various elements from the prior art and combine them in the claimed manner. In other words, a patent examiner or court must show some suggestion or motivation, prior to the applicant’s invention, to support a

rejection based upon a new combination of prior art references. *In re Rouffet*, 149 F.3d 1350, 1355-56 (Fed. Cir. 1998). The requirement of a suggestion to combine is the first of the three above-noted criteria of a *prima facie* case of obviousness.

More particularly, given the “subtle but powerful attraction of a hindsight-based obviousness analysis,” the law requires a “rigorous application of the requirement for a showing of the teaching or motivation to combine prior art references.” *In re Dembiczak*, 175 F.3d 994, 999 (Fed. Cir. 1999). Thus, to properly support a proffered combination of references, a patent examiner “must identify specifically . . . the reasons one of ordinary skill in the art would have been motivated to select the references and combine them” in the proffered manner. *In re Rouffet*, 149 F.3d at 1359. Close adherence to this rigid methodology is especially important in the case of less technologically complex inventions, where the very ease with which the invention can be understood may prompt one “to fall victim to the insidious effect of a hindsight syndrome wherein that which only the inventor taught is used against its teacher.” *Dembiczak*, 175 F.3d at 999 (citing *W.L. Gore & Assoc., Inc. v. Garlock, Inc.*, 721 F.2d 1540, 1553 (Fed. Cir. 1983)). Additionally, it is never appropriate for an Examiner to rely solely on “common knowledge in the art” without evidentiary support in the record as the principal evidence upon which a rejection was based. *MPEP* § 2144.03.

In the present obviousness rejections, the Examiner has selectively combined: (a) Petrone with Berry; (b) Petrone with Desjardins; and (c) Evans with Berry. The primary references of Petrone and Evans are limited to use with dumbbells. Petrone relates to a device for storing and presenting dumbbells, and makes no mention whatsoever of having utility with barbells. Evans relates to a weight bench for supporting dumbbells, and makes no mention whatsoever of having utility with barbells.

The secondary references of Berry and Desjardins are not appropriate for dumbbell use. Berry relates to an apparatus for adjusting the amount of weight carried by a barbell or a weight machine, and makes no mention whatsoever of having utility with dumbbells. Desjardins relates to a weightlifting power station for use with barbells, and makes no mention whatsoever of having utility with dumbbells.

In support of the rejections of claims 1, 2, and 4-8 under 35 U.S.C. 103(a) as being unpatentable over Petrone in view of Berry, the Examiner states that “it would have been obvious to

one of ordinary skill in the art to include bars on the device of Petrone for the purpose of aiding in stabilizing the exercise device of Petrone.” There is simply no support for this conclusion. In fact, the references themselves teach away from this combination. Since Petrone discloses elongated tubular base members (14, 16) that provide adequate support and stabilization for the apparatus, there is no need for supplemental stabilization. Also, since Petrone is limited to use with dumbbells, the addition of a cable-carried weight platform like that of Berry to adjust the weight carried by the supported dumbbells would necessarily make the dumbbells *less stable*, or, at the very least, much more awkward for a user to grasp. One skilled in the art would therefore be *motivated against* the combination of Petrone with Berry.

Furthermore, the Petrone/Berry combination fails to render the invention of claims 1, 2, and 4-8 obvious because the proffered combination (even if it were supported – which it is not) does not teach a lower “stand” section as is recited. The term “stand” is used herein in a manner consistent with the Merriam Webster’s definition of “a frame on or in which something may be placed for support.” The weight-carrying cables/tubing of Berry simply do not equate to a stand.

Furthermore, the gas springs (108, 110) of Petrone (claimed by the Examiner to constitute arms) are not “opposing” as is presently claimed. Thus, these claim rejections predicated on the combination of Petrone with Berry are not supportable for several reasons.

In support of his rejection of claims 1-3, 12, and 20 under 35 U.S.C. 103(a) as being unpatentable over Petrone in view of Desjardins, the Examiner states “it would have been obvious to include the horizontally extending weight plate supporting bars on the lower [e]nd of the vertical stand of Petrone in view of the plurality of bars (88) located at the lower end on the frame member of Desjardins.” There is simply no support for this conclusion. Again, the references themselves teach away from this combination. The cradles (50, 52) of Petrone are specifically suited for dumbbells and are not adaptable for use with the barbell cradles (70), etc. of Desjardins. Also, since Petrone is limited to use with dumbbells – which do not require independent weight plates as barbells do – there may never be a need for weight plate-storage bars as is recited by claim 1 (“bars ... upon which weight-training plates having bores therethrough may be stored”). One skilled in the art would therefore be *motivated against* the combination of Petrone with Desjardins.

Furthermore, the gas springs (108, 110) of Petrone (claimed by the Examiner to constitute

arms) are not “opposing” as is presently recited in claim 1. Additionally, as mentioned above in the discussion concerning the anticipation rejections, Desjardins fails to disclose the inclined arms of claim 12. Thus, these claim rejections predicated on the combination of Petrone with Desjardins are not supportable for several reasons.

The Examiner’s obviousness rejection of claims 10, 19, and 22 that are also predicated on the combination of Petrone with Desjardins is traversed for the same reasons (presented above). This conclusion is not changed by the fact that the Examiner failed to identify the patent number for the cited Ho reference, which was also applied to the Petrone/Desjardins combination.

In support of his rejection of claims 1 and 9 under 35 U.S.C. 103(a) as being unpatentable over Evans in view of Berry, the Examiner stated “it would have been obvious to one of ordinary skill in the art to provide similar bar members on the device of Evans for the purpose of storing weight plates and stabilizing the device by adding weight.” There is simply no support for this conclusion. Again, the references themselves teach away from this combination. Since Evans is limited to use with dumbbells, the addition of a tubing/cable-carried weight platform like that of Berry to adjust the weight carried by the supported dumbbells would necessarily make the dumbbells *less stable*, or, at the very least, much more awkward for a user to grasp. One skilled in the art would therefore be *motivated against* the combination of Evans with Berry.

Furthermore, the Evans/Berry combination fails to render the invention of claim 10 obvious because the proffered combination (even if it were supported – which it is not) does not teach a lower “stand” section as is recited by claim 1, from which claim 10 depends. The term “stand” is used herein in a manner consistent with the Merriam Webster’s definition of “a frame on or in which something may be placed for support.” The carrying cables/tubes, etc. of Berry simply do not equate to a stand.

Additionally, as mentioned above in the discussion concerning the anticipation rejections, Evans fails to disclose the “arms that incline outwardly from opposing sides of the column” of claim 12, which is required by rejected claims 19 and 22 that depend from claim 12. Thus, these claim rejections predicated on the combination of Evans with Berry are not supportable for several reasons.

Claims 14-16 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Desjardins. This rejection is respectfully traversed for the reasons expressed above concerning the anticipation

rejections (i.e., no teaching of "arms that incline outwardly from opposing sides of the column" as required by claim 12, from which claims 14-16 depend).

In consideration of the above discussion concerning the obviousness rejections, reconsideration and withdrawal of these rejections are respectfully requested.

Conclusion

This response is believed to place all pending claims in condition for allowance, and such action is earnestly solicited. In the event that the Examiner is not fully persuaded by this response, the Examiner is respectfully requested to contact the undersigned attorney for the Applicants by telephone to discuss this response.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "Steven Christian", with a stylized, cursive script.

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